

In re patent application of

CHOO, YEN et al.

Serial No. 09/424,482

Filed: February 29, 2000

For: NUCLEIC ACID BINDING POLYPEPTIDE LIBRARY

STATEMENT TO SUPPORT FILING AND SUBMISSION IN  
ACCORDANCE WITH 37 C.F.R. §§ 1.821-1.825

Assistant Commissioner for Patents  
Washington, D.C. 20231  
Box SEQUENCE

Sir:

In connection with a Sequence Listing submitted concurrently herewith, the undersigned hereby states that:

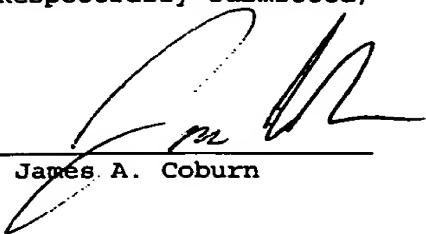
1. the submission, filed herewith in accordance with 37 C.F.R. § 1.821(g), does not include new matter;

2. the content of the attached paper copy and the attached computer readable copy of the Sequence Listing, submitted in accordance with 37 C.F.R. § 1.821(c) and (e), respectively, are the same; and

3. all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent resulting therefrom.

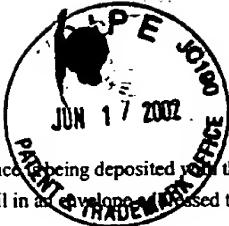
Respectfully submitted,

  
\_\_\_\_\_  
James A. Coburn

Sept. 28, 2001

Date

HARBOR CONSULTING  
Intellectual Property Services  
1500A Lafayette Road  
Suite 262  
Portsmouth, N.H.  
800-318-3021



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Assistant Commissioner for Patents  
Washington, D.C. 20231

On June 6, 2002

TOWNSEND and TOWNSEND and CREW LLP

By: Paula Faull & Henley

PATENT  
Attorney Docket No.: 019496-00610US  
Client Ref. No.: 67US

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Mark Choo et al.

Application No.: 09/424,482

Filed: February 29, 2000

For: NUCLEIC ACID BINDING  
POLYPEPTIDE LIBRARY

Examiner: T. Bhatti

Art Unit: 1627

COMMUNICATION

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

As stated by the Examiner in her phone message of June 4, 2002, the Office communication mailed May 6, 2002 was sent in error. The incomplete requirements noted, i.e. revision of Figure 2 to comply with sequence rules, and supplying CRF and paper copies of the sequence listing, had been previously fulfilled by preliminary amendments submitted October 12, 2001, and February 28, 2002.

As requested by the Examiner in her phone message, Applicants enclose herewith copies of documents previously submitted February 28, 2002, in order to comply with Requirements For Patent Applications Containing Nucleotide Sequence And/or Amino Acid Sequence Disclosures. The materials enclosed are:

1. Preliminary amendment submitted February 28, 2002;

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Mark Choo et al.  
Application No.: 09/424,482  
Page 2

2. Transmittal form dated February 28, 2002;
3. Postcard receipt for materials mailed February 28, 2002, stamped with dates March 6, 2002, and April 1, 2002, and returned by USPTO;
4. Office communication mailed January 29, 2001 including Notice To Comply With Requirements For patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

The preliminary amendment mailed February 28, 2002, also included copies of the following documents filed October 12, 2001 to fulfill sequence listing requirements for the instant application. These documents are also enclosed:

1. Preliminary amendment submitted October 12, 2001;
2. Substitute sequence listing containing 114 sequences;
3. Statement to Support Filing and Submission in Accordance with 37 C.F.R. §1.821-1.825;
4. Receipt from PTO for these materials dated October 12, 2001.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Joe Liebeschuetz  
Reg. No. 37,505

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (415) 576-0200  
Fax: (415) 576-0300  
JOL:adm  
PA 3227537 v1

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UNITED STATES PATENT AND TRADEMARK OFFICE

Mailing Date: February 28, 2002 Via First Class Mail  
Application of: Choo et al.  
Title: Nucleic Acid Binding Polypeptide Library  
Serial No.: 09/424,482 Filed: February 29, 2000

Please stamp the date of receipt of the enclosed documents and return this card to addressee:  
Transmittal form (1 p.);  
Copy of Notice to Comply with Requirements for Applications w/ Sequence Disclosures (3 p.);  
Amendment (10 pp.);  
Copy of previously filed Sequence Listing (46 pp.);  
CRF of Sequence List; and  
Return Postcard

File No. 019496-0006210US  
PA 3202953 v1

APR 01 2002

Atty/Secty: JOL/pfh

O I P E 30180  
JUN 17 2002  
M A R 0 6 2002  
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**TRANSMITTAL  
FORM JUN 17 2002**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

57

|                      |                   |
|----------------------|-------------------|
| Application Number   | 09/424,482        |
| Filing Date          | February 29, 2000 |
| First Named Inventor | CHOO, Yen         |
| Group Art Unit       | 1627              |
| Examiner Name        | Bhatti, Tahira H. |

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| ENCLOSURES (check all that apply)   |  |   |   |
|---|--|---|---|
| <input type="checkbox"/> Fee Transmittal Form                                 | <input type="checkbox"/> Assignment Papers<br>(for an Application)                         | <input type="checkbox"/> After Allowance Communication to Group                               |   |
| <input type="checkbox"/> Fee Attached   | <input type="checkbox"/> Drawing(s)  | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences           |   |
| <input type="checkbox"/> Amendment / Response                                 | <input type="checkbox"/> Licensing-related Papers  | <input type="checkbox"/> Appeal Communication to Group<br>(Appeal Notice, Brief, Reply Brief) |   |
| <input type="checkbox"/> After Final  | <input type="checkbox"/> Petition Routing Slip (PTO/SB/69)<br>and Accompanying Petition    | <input type="checkbox"/> Proprietary Information  |   |
| <input type="checkbox"/> Affidavits/declaration(s)                            | <input type="checkbox"/> Petition to Convert to a Provisional Application                  | <input type="checkbox"/> Status Letter  |   |
| <input type="checkbox"/> Extension of Time Request                            | <input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s)<br>(please identify below):            |   |
| <input type="checkbox"/> Express Abandonment Request                          | <input type="checkbox"/> Terminal Disclaimer   | Return Postcard   |   |
| <input type="checkbox"/> Information Disclosure Statement                     | <input type="checkbox"/> Request for Refund  | Amendment (10 pp.)  |   |
| <input type="checkbox"/> Certified Copy of Priority Document(s)               | <input type="checkbox"/> CD, Number of CD(s)   | Copy of Notice to Comply with Requirements  |   |
| <input type="checkbox"/> Response to Missing Parts/<br>Incomplete Application | <td>Remarks</td>   | Remarks   | Copy of previously submitted Sequence Listing (46 pp.). |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53  |  | CRF Sequence List   |   |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|                          |  |                 |
|--------------------------|--|-----------------|
| Firm and Individual name | Townsend and Townsend and Crew LLP<br>Joe Liebeschuetz | Reg. No. 37,505 |
| Signature                |  |                 |
| Date                     | February 28, 2002                                      |                 |

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date:

February 28, 2002

|                       |                   |
|-----------------------|-------------------|
| Typed or printed name | Paula Faulk Hudey |
| Signature             |                   |
| Date                  | February 28, 2002 |

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.  
PA 3202952 v1



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## RECEIPT FROM PTO FOR INDICATED ITEMS

(Do NOT Use for New or Continuing Applications of Any Kind)  
Use 2 postcards for all New Applns. (cont/Div/CIP, too)  
Use this sheet when filing CPA

|                       |                        |
|-----------------------|------------------------|
| Appln. No: 09/424,482 | Atty: Blair E. Taylor  |
| First Inventor: CHOO  | Date: October 12, 2001 |
|                       | Matter No: 264974      |
|                       | Client No: 71278       |

## ENCLOSED:

Response/Amendment     Appendix     Cover Sheet     Cited>Listed Documents

Completion Request for R 53(f)/PCT Nat.

# No. of Pages Abstract

# No. of Pages Spec and Claims

# No. of Numbered Claims Only

# No. of Sheets of Drawings (Figs)

1 Set Formal     1 Set Informal     Cover Letter

Declaration     # of pages

Assignment     Cover Sheet

Small Entity Declaration

Extension Petition (PAT-111)

#  No. of Priority Documents

IDS Letter     Cited Appln(s)  Foreign Sch Rep/OA

PTO-1449     Cited Documents

Issue Fee Transmittal Form PTOL-85(b) + (c)

\$  460.00      Fee (Check)

## OTHER:

LETTER TO THE OFFICIAL DRAFTSPERSON; STATEMENT TO SUPPORT FILING AND SUBMISSION IN ACCORDANCE WITH 37 CFR § 1.821-1.825 (WITH PAPER AND CRF SEQUENCE LISTING); AND PETITION FOR REFUND OF FEES UNDER 37 CFR § 1.182

Current DUE DATE:  October 21, 2001

(Submit Single Copy Only)

**TRANSMITTAL  
FORM**

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|  |    |                        |                 |
|--|----|------------------------|-----------------|
| Total Number of Pages in This Submission | 64 | Attorney Docket Number | 019496-006210US |
|--|----|------------------------|-----------------|

**ENCLOSURES (check all that apply)**

|   |  |  |
|---|--|--|
| <input type="checkbox"/> Fee Transmittal Form                   | <input type="checkbox"/> Assignment Papers<br><i>(for an Application)</i>                  | <input type="checkbox"/> After Allowance Communication to Group  |
| <input type="checkbox"/> Fee Attached                           | <input type="checkbox"/> Drawing(s)  | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  |
| <input type="checkbox"/> Amendment / Response                   | <input type="checkbox"/> Licensing-related Papers  | <input type="checkbox"/> Appeal Communication to Group<br><i>(Appeal Notice, Brief, Reply Brief)</i>   |
| <input type="checkbox"/> After Final                            | <input type="checkbox"/> Petition Routing Slip (PTO/SB/69)<br>and Accompanying Petition    | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)              | <input type="checkbox"/> Petition to Convert to a Provisional Application                  | <input type="checkbox"/> Status Letter   |
| <input type="checkbox"/> Extension of Time Request              | <input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s)<br><i>(please identify below):</i>  |
| <input type="checkbox"/> Express Abandonment Request            | <input type="checkbox"/> Terminal Disclaimer   | Return Postcard Communication<br>Copies of:  |
| <input type="checkbox"/> Information Disclosure Statement       | <input type="checkbox"/> Request for Refund  | 1. Preliminary amendment submitted February 28, 2002;<br>2. Transmittal form dated February 28, 2002;<br>3. Postcard receipt for materials mailed February 28, 2002, stamped with dates March 6, 2002 and returned by USPTO;<br>4. Office communication mailed January 29, 2001 including Notice To Comply...<br>5. Preliminary amendment submitted October 12, 2001;<br>6. Substitute sequence listing containing 114 sequences;<br>7. Statement to Support Filing and Submission in Accordance with 37 C.F.R. §1.821-1.825;<br>8. Receipt from PTO for these materials dated October 12, 2001. |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of CD(s)   |  |
|   | Remarks  | The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.   |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|                          |  |  |
|--------------------------|--|--|
| Firm and Individual name | Townsend and Townsend and Crew LLP<br>Joe Liebeschuetz |  |
| Signature                |  |  |
| Date                     | June 6, 2002   |  |

**CERTIFICATE OF MAILING**

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June 6, 2002

|                       |                    |              |
|-----------------------|--------------------|--------------|
| Typed or printed name | Paula Faulk Hurley |              |
| Signature             |                    |              |
|                       | Date               | June 6, 2002 |



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UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/424,482  | 02/29/2000  | CHOO                 | PM264974            | 8038             |
| 909   | 7590        | 01/29/2002           |                     |                  |
| PILLSBURY WINTHROP LLP<br>1600 TYSONS BOULEVARD<br>MCLEAN, VA 22102 |             |                      | EXAMINER            |                  |
|   |             |                      | BHATTI, TAHIRA H    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1627                |                  |

DATE MAILED: 01/29/2002

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FEB 04 2002

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ATTY(S) \_\_\_\_\_  
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019496 - 006210

Docket 3-1-02  
RPA



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 09424482      | 2/29/2000   | Yen Choo              |                     |

| EXAMINER      |              |
|---------------|--------------|
| Tahira Bhatti |              |
| ART UNIT      | PAPER NUMBER |
| 1627          | 19           |
| DATE MAILED:  |              |

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Please find below a communication from the EXAMINER in charge of this application.

The communication filed on 3/30/01, is not fully responsive to the communication mailed 6/20/01.

Since the response appears to be bona fide, but through an apparent oversight or inadvertence failed to provide a complete response, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication should be directed to Tahir Bhatti whose telephone number is (703) 605-1203. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

PADMASHRI PONNALURI  
PRIMARY EXAMINER  
for SPE

Application No.: 09/424

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING  
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):



- 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."
- 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- 7. Other: The applicant has not fully complied with sequence listing rules, which requires the use of SEQ ID NO. See for e.g. claim 20 and page 18 of the specification do not comply with the sequence rules as required by 37 CFR 1.82 (d).

**Applicant Must Provide:**

- An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

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